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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Tri/Mark Corporation

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Serial No. 76159890

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Wendy K. Marsh of McKee, Voorhees & Sease for Tri/Mark Corporation.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

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Before Simms, Seeherman and Hairston, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Tri/Mark Corporation ("applicant"), an Iowa corporation, has appealed from the final refusal of the Trademark Examining Attorney to register, on the Supplemental Register, the mark E-ACCESS for the goods set forth below:

> latches and handles having electronic locks for vehicular applications, namely, for fire trucks; latches and

handles having electronic locks for freestanding industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipment, in Class 9;

latches and handles having electronic locks for vehicular applications, namely, for agricultural and construction vehicles, motor homes, travel trailers, utility and service trucks, ambulances, bus and motor coaches, light, medium and heavy duty trucks, pick-up truck caps, fitted pick-up truck covers, fitted pick-up truck toolboxes, off-road vehicles in the nature of all-terrain vehicles, lawn tractors and golf cars in Class 12.[1]

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[1] Application Serial No. 76159890, filed November 6, 2000, on the basis of an allegation of applicant's bona fide intention to use the mark in commerce. The Examining Attorney had refused to register the mark on the basis that it was merely descriptive of applicant's goods. Applicant then amended this application to the Supplemental Register with the filing of an amendment to allege use on December 6, 2002. Because of applicant's amendment to the Supplemental Register, the effective filing date of this application becomes the date applicant amended to the Supplemental Register upon filing an acceptable amendment to allege use. See TMEP §815.02 (Third Edition 2002). (The amendment to allege use recites dates of use of November 26, 2002.) While initially refusing to accept the amendment to allege use because of the rejection of the specimen as evidence of trademark use, in her brief (unnumbered page 3) the Examining Attorney accepted the amendment to allege use as meeting the minimum requirements of such an amendment. As a result of the amendment to the Supplemental Register, the Examining attorney withdrew the refusal under Section 2(e)(1).

The Examining Attorney had required applicant to amend its listing of goods because its goods were indefinitely described, overly broad, partially misclassified and beyond the scope of the original identification, according to the Examining Attorney. In its reply brief, 5, applicant adopted the proposed identification suggested by the Examining Attorney, set forth above. Accordingly, the

The only issue before us is the acceptability of the specimen of record as evidence of trademark use of the mark sought to be registered. Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.

The Examining Attorney argues that the specimen (shown below) is not acceptable because it is merely an advertisement for applicant's E-ACCESS goods and that, because of this improper use, applicant's mark fails to function as a trademark for its goods.

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issue of the acceptability of applicant's identification of goods is no longer before us.

According to the Examining Attorney, the issue turns on whether the specimen is packaging for the goods or merely an advertisement for the goods. The Examining Attorney states that the reference to the mark E-ACCESS on the package is merely an advertisement for goods other than those contained in the packaging.

> A packaging label is only acceptable as a specimen if the label contains a mark which would be viewed by the public as a source indicator for the particular goods within the packaging. While the label in applicant's specimen may be acceptable for OTHER marks, such as, TRI MARK or EASK, it is not acceptable for E-ACCESS because that mark is not shown as a source indicator **for the goods contained within the packaging.** The term E-ACCESS is featured only as part of a secondary advertisement for applicant's other goods. In other words, the label contains a mark for the goods within the packaging, TRI MARK EASK, and also an advertisement for its other new line of products which consumers may wish to purchase, including E-ACCESS.

Brief, unnumbered page 5 (emphasis in original). The Examining Attorney maintains that the public will not perceive the mark E-ACCESS as a trademark for the goods in the packaging, and that there is no showing that the specimen shows a label for a box containing applicant's E-ACCESS goods.

Applicant, on the other hand, argues that the product label is acceptable to show trademark use because it is a digital photograph of a label applied to the product packaging containing applicant's E-ACCESS product. Brief, 2, 3 and reply brief, 4. In other words, applicant maintains that the package shown above does contain its E-ACCESS latches and handles having electronic locks listed in the application. Because the mark appears on a label applied to the packaging, applicant maintains that the specimen does not cease to be a label merely because it may also contain advertising.

As support for its position, applicant refers to various sections of the Trademark Manual of Examining Procedure. TMEP §904 indicates that "[a] trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods." Further, TMEP §904.04 indicates that "[i]n most cases, where the trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen." Applicant also notes that, in an application to register the mark E-PAD (Serial No. 78086382), a mark also shown on the specimen of record, the Examining Attorney handling that case allowed that mark on the basis of the same specimen. (The Examining Attorney responds to this

argument by arguing that each case must be considered on its own merits.)

We note that in the amendment to allege use, applicant states that "The specimen consists of a digital photo of a label on the product packaging."

Section 23 of the Act, 15 USC §1091, provides, in part:

> All marks capable of distinguishing applicant's goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 2 of this Act, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1 so far as they are applicable.

Subsection (a) of Section 1 of the Act, 15 USC §1051, provides that the owner of a trademark used in commerce must submit such number of specimens or facsimiles of the mark as used as may be required by the Director. Trademark Rule 2.56(a) provides that an amendment to allege use under Rule 2.76 must include one specimen showing the mark as used on or in connection with the goods. Rule 2.56(b)(1) provides that a trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. Trademark Rule 2.56(c) indicates that a photocopy

or other reproduction of a specimen of the mark as actually used on or in connection with the goods is acceptable.

Section 904.04 of the Trademark Manual of Examining Procedure provides that such a specimen must show the mark as used on or in connection with the goods in commerce. While Section 904.04(c) states that a showing of the trademark on the normal commercial package for the particular goods is an acceptable specimen, advertising material is generally not acceptable as a specimen for goods. TMEP §904.05. Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use.

The question of whether a designation serves as a mark must be determined on the basis of the manner and context in which the designation is used, as revealed by the specimen and other literature of record, and the significance which the designation is likely to have to members of the relevant public because of the manner in which it is used. Therefore, in order to determine whether applicant's specimen shows the mark as used on the goods, we must examine the specimen itself because it shows the manner in which the mark is seen by the public. Applicant has submitted what it describes as packaging for its E-

ACCESS goods. At the top in prominent letters is the mark Tri*Mark*, followed by the wording "**e**lectronic **A**ccess **S**ecurity **K**eyless-entry." There follows the statement "TriMark has the expanded ability to provide comprehensive electromechanical access solutions through their new line of electronic-enabled products:", followed by a listing of seven trademarks, including the one here sought to be registered. On the next line the packaging indicates the "System kits are available and include handles, latches and power lock actuators."

We agree with the Examining Attorney that prospective purchasers of applicant's goods would perceive the mark for the product on which the label appears as TriMark, and/or **e**lectronic **A**ccess **S**ecurity **K**eyless-entry. The applied-for mark is one of seven marks which the purchaser will likely perceive as one of the marks for applicant's new line of electronic-enabled products, and not as the mark for the product contained in the package. Accordingly, the digital photograph which applicant has submitted as its specimen does not show use of the applied-for mark for the goods.

Decision: The refusal of registration is affirmed.